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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/722,440	11/28/2000	Piero Pollesello	1102.0250003/JMC	5322

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EXAMINER

KAM, CHIH MIN

ART UNIT PAPER NUMBER

1653

DATE MAILED: 12/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/722,440

Applicant(s)

POLLESELLO ET AL.-

Examiner

Chih-Min Kam

Art Unit

1653

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 November 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: 9,11 and 12.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 20-32.

Claim(s) withdrawn from consideration: 33.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

  
CHRISTOPHER S. F. LOW  
SUPERVISOR/PAID EXAMINER  
TECHNOLOGY CENTER 1600

Continuation of 2. NOTE: The amendment to the claims does not resolve the current issues regarding obviousness-type double patenting and under 35 USC 112, second paragraph. In the amendment of November 13, 2003, claims 20, 23-29 and 31 have been amended. Applicants' response has been fully considered, however, claims 20-32 remain rejected under judicially created doctrine of obviousness-type double patenting and under 35 USC 112, second paragraph.

If applicants' amendment were entered, it would have the following response:

1. Claims 20-32 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 11-20 and 22-41 of copending application No. 09/722,497. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. In response, applicants indicate since the rejection is provisional, applicants elect not to contest the propriety of this rejection at this time, and further assert that in view of the foregoing amendment and other arguments, should the provisional obviousness-type double patenting rejection be the only rejection remaining, applicants request withdrawal of the rejection (pages 10-11 of the response). The response is unpersuasive because this rejection is not the only remaining rejection, and the ground of rejection remains, no allowable material can be indicated when a ground of rejection remains.
2. Claims 20-32 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite because of the use of the term "a portion of the phospholamban cytosolic domain that allows binding of the phospholamban deactivator to phospholamban". The term cited above renders the claim indefinite, it is not clear what amino acid residues in the phospholamban cytosolic domain are the portion that allows binding of the phospholamban deactivator to phospholamban. Claims 21-30 and 32 are included in this rejection for being dependent on a rejected claim and not correcting the deficiency of the claim from which they depend. In response, applicants indicate claims 20 and 31 have been amended regarding "ligand-binding portion", and "a ligand-binding portion" is not necessarily synonymous with "a ligand-binding site", and "the portion of the phospholamban cytosolic domain that allows binding of the phospholamban deactivator to phospholamban" can be the binding site (S1-S4) or the 36 amino acids disclosed by SEQ ID NO:9 (pages 11-12 of the response). The response has been fully considered, however, the argument is not persuasive because the claim does not identify the amino acid residues in the phospholamban cytosolic domain as the portion that binds the phospholamban deactivator, it is not clear what the portion of phospholamban cytosolic domain is.

Continuation of 5. does NOT place the application in condition for allowance because: The amendment to the claims does not resolve current issue regarding obviousness-type double patenting and 35 USC 112, second paragraph.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Min Kam whose telephone number is (703) 308-9437. The examiner can normally be reached on 8.00-4:30, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, Ph. D. can be reached on (703) 308-2923. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 308-4227 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Chih-Min Kam, Ph. D. *CMK*  
December 9, 2003